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A. Claims 10-13, 15-18 and 20-29

The Examiner has rejected claims 10-13, 15-18 and 20-29 as being obvious under 35 U.S.C. §103 over Shaw et al. (U.S. Patent No. 6,104,392, issued August 15, 2000, hereinafter "Shaw") in view of Utsumi (U.S. Patent No. 6,195,677, issued February 27, 2001, hereinafter "Utsumi"). The applicants respectfully traverse the rejection.

In particular, claim 10, as amended, recites:

"A method of adapting asset delivery within a heterogeneous video-on-demand distribution system having service provider equipment and at least one set top terminal, comprising the steps of:

determining at the service provider equipment, for each set top terminal (STT) requesting a session for video content in the video-on-demand distribution system, a capability level of said STT and a capability level of the distribution network;

selecting, from a plurality of available video content and navigational assets stored on service provider equipment, video content and navigational assets appropriate to said capability level of said STT; and

providing said selected video content and navigational assets in response to STT communications indicative of a need for said video content and assets, wherein said navigational assets comprise video information, graphics information, and control information." (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

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Neither the Shaw reference nor the Utsumi reference, either singularly or in combination, teach the applicants' invention as a whole. In particular, the Shaw reference discloses:

"In a client-server architecture, an Adaptive Internet Protocol (AIP) system, comprised of a display engine operating on a server and a protocol engine operating on a server, providing means to support standard graphics based computer applications connected to clients of varying capability via a network of varying bandwidth and latency by automatically varying the type and number of graphic requests and their networking encoding to provide near optimum performance while maintaining the correct visual representation."
(See Shaw, Abstract)

Nowhere in the Shaw reference is there any teaching or suggestion of "determining at the service provider equipment, for each set top terminal (STT) requesting a session for video content in the video-on-demand distribution system, a capability level of said STT and a capability level of the distribution network." By contrast, the Shaw reference discloses a client server relationship as between a conventional application server and a client device such as a character based or window based or web user interface device. (See Shaw, column 2, lines 21-23). More specifically, Shaw discloses a client-server network that provides at least one application service for selection by a user via a client device having a display engine operating thereon. (See Shaw, column 3, line 66 to column 4, line 2). Nowhere is there any teaching of a set top terminal, as defined by the applicants.

A set top terminal (STT) as defined by the applicants, is capable of processing video information streams and associated audio information streams. As shown in Figure 2 of the applicants' invention, each receiver 204 and 210 contains a tuner, amplifiers, filters, a demodulator and a depacketizer. As such, the set-top terminal tunes, downconverts and depacketizes the signals from the cable network in a conventional manner (See Specification page 13, lines 16-19). Nowhere in the Shaw reference is there any teaching or suggestion that the

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client devices of Shaw tune, downconvert, depacketize or operate in a similar manner as defined by the applicants' set-top terminal.

In this instance, the Examiner has impermissibly picked and chose various limitations regarding display engines that determine support of display operations at the client devices, without considering that these client devices are not set top terminals as defined by the applicants. That is, the client devices of Shaw discloses that the client devices generally include a PC, a Unix computer, a network computer, illustratively having a java virtual machine interface to a server having various engines or processors executing thereon. (See Shaw, column 5, lines 40-60 and Figure 1). Accordingly, the Shaw reference discloses client devices that are associated with windows and web browser-type applications, as opposed to the applicants' invention, which is a set top terminal that tunes, demodulates and depacketizes video-on-demand information from a service provider.

Further, the Utsumi reference fails to bridge the substantial gap as between the Shaw reference and the applicants' invention. In particular, the Utsumi reference merely discloses a data exchange process that performs a series of processing operations to convert data as an application service into another data in correspondence with the attribute of each terminal or communication infrastructure. (See Utsumi, column 14, lines 48-52 and Figure 2). Moreover, the terminal type determining section of Utsumi determines the type of user terminal (e.g. a large screen desk top PC, a portable small screen sub-notebook PC, and PDA). (See column 14, line 65 to column 15, line 1). In other words, the Utsumi reference also fails to teach or suggest a set top terminal as conventionally known by a person of ordinary skill in the art and as also defined by the applicants.

Moreover, even if these two references could somehow be operably combined (and the applicants submit that the two references may not be operably combined) the combination would merely disclose a server providing graphical and video information to a client device such as a PC, PDA, Unix desk top system and the like where a terminal-type determining section provides

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information to a data exchange process section to perform a series of processing operations to convert data as an application service into another data in correspondence with the attribute of each terminal or communication infrastructure. This is completely different from the applicants' invention. Specifically, the applicants' invention is a video-on-demand (VOD) system that provides video content and navigational information in the form of graphical data, which is sent to a set top terminal that is able to tune, demodulate and depacketize the such video-on-demand services from the service provider.

It is noted that the video-on-demand services, as conventionally known by a person of ordinary skill in the art, include providing such video content (e.g. movies) to the subscribers through the set top terminal such that a subscriber may view such video content and interact with the navigational screen so that the content may be viewed in a VCR-like manner (i.e., having fast forward, rewind, stop, pause, play commands). None of the devices as described in the Shaw and Utsumi references are considered by a person of ordinary skill in the art as "a set top terminal." Therefore, the Examiner has improperly combined the Shaw and Utsumi reference since they fail to teach or suggest providing video-on-demand or a set top terminal, and the references fail to teach or suggest the applicants' invention as a whole.

As such, the applicants submit that claim 10 is not obvious and fully satisfies the requirements under 35 U.S.C. §103 as patentable thereunder. Likewise, independent claim 17 recites similar limitations as recited in independent claim 10. As such, the applicants submit that claim 17 is not obvious and fully satisfies the requirements under 35 U.S.C. §103 as patentable thereunder. Furthermore, claims 11-13, 15, 18 and 20-29 respectively depend, either directly or indirectly, from independent claims 10 and 17 and recite additional limitations thereof. As such, and for at least the same reasons as discussed above, the applicants submit that these dependent claims are also not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

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Conclusion

Thus, the applicants submit that claims 10-13, 15-18, and 20-29 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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